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DIRECTOR
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In re Application of
Osamu Yokomizo et al.
Application No. 08/470,424
Filed: June 6, 1995
For: FUEL ASSEMBLY AND NUCLEAR
REACTOR

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ON PETITION

This is a decision on the petition filed April 4, 1997, requesting the Commissioner invoke his supervisory authority under 37 CFR 1.181(a)(3) and review the Group Director's decisions on petition mailed December 31, 1996 and February 6, 1997. The petition is being treated as a request for reconsideration of the decisions mailed May 31, 1996 and February 6, 1997.

The petition is granted to the extent indicated below.

BACKGROUND

The above-identified application was filed on June 6, 1995 containing 23 claims, each directed to an apparatus.

An Office action was mailed February 29, 1996, which required an election under 35 U.S.C. 121 between three embodiments, identified as I-III, and further between several embodiments, identified as A-J.

A response to this action was filed March 29, 1996, in which applicant elected with traverse the species designated I, B.

An amendment was filed on June 14, 1996, which presented new claims 24-29, each directed to a method but all, according to applicant, readable on the elected species.

In an Office action mailed July 5, 1996 the examiner held that the newly submitted claims 24-29 were directed to an invention independent and distinct from the invention originally presented and originally elected in the March 29, 1996 response.

The examiner set forth a requirement for restriction between claims 1-23, directed to an apparatus, and claims 24-29, directed to a method. The examiner then held the apparatus of claims 1-23 were constructively elected by original presentation of claims as well as by the specific prior election of species I,B of the apparatus claims, and withdrew newly submitted claims 24-29 from consideration as being directed to a non-elected invention, in accordance with 37 CFR 1.142(b), 37 CFR 1.145 and MPEP § 821.03. The examiner then issued an Office action on the merits of those apparatus claims which the examiner held to be readable on the elected species, and held claims 24-29 withdrawn from further consideration.

A petition was filed on July 30, 1996, requesting that the examiner issue an Office action which would set forth a new requirement for restriction and which would provide petitioner an opportunity to elect between the restricted inventions. The petition was treated as a petition under 37 CFR 1.181 for review of the examiner's requirement for restriction and issuance of a complete Office action, and which petition was denied in the decision of the Director on December 31, 1996.

On January 7, 1997 a renewed petition for issuance of a complete Office action and a new requirement for restriction was filed, which petition was denied in the decision of the Director on February 6, 1997.

On April 4, 1997, the instant petition was filed.

A final office action was mailed May 12, 1997, which indicated that claims 24-29 remained withdrawn from further consideration.

On November 12, 1997, a Notice of Appeal from the final rejection of claims 4-7,23, and 30-37 was filed, accompanied by the necessary petition for extension of time under 37 CFR 1.136(a).

OPINION

Petitioner requests issuance of a "complete " office action, i.e., one that includes both consideration of claims 24-29, as well as "new requirements for restriction."

Taking the latter request first, petitioner has not shown, nor does inspection of the record reveal, any error in either the restriction requirements of record, or in the previous decisions, that would warrant issuance of any further requirement(s) for election of specie(s). Inspection of the election of species requirements of record indicates that each was made in accord with the practice set forth in MPEP 809.02(a). Petitioner was

clearly able to understand and respond to the requirements of February 29, 1996, and July 5, 1996. While petitioner disagrees with the subsequent treatment of claims 24-29, such does not, *per se*, demonstrate error in the election requirements of record. Rather, the treatment of claims that the examiner holds to be drawn to a nonelected invention (or species) is set forth in MPEP 821 et seq. As such, the previous decisions were not arbitrary or capricious to the extent that they denied petitioner's request for the issuance of any further election requirements.

With respect to the second issue, petitioner is correct in asserting that the election of species requirement of February 29, 1996 cannot be considered an action on the merits, as set forth in MPEP 809.02(a). Rather, as set forth in MPEP 818.01, the Office action of July 5, 1996, as it treated various claims on the merits which served to fix the election. Petitioner is therefore correct in asserting that to the extent the examiner's actions, and the previous decisions, hold that, due to original presentation, claims 24-29 can be considered withdrawn due to constructive election by original presentation, such is clearly error. However, this would be harmless error, in that, as noted below, claims 24-29 were also held to be not readable on the elected species, which, in the absence of more, would not support any further consideration of claims 24-29 on the record.

Nevertheless, inspection of the record reveals that claims 24-29 have not been treated in accordance with Office policy.

The supplemental amendment of June 14, 1996, proffered claims 24-29 and in the accompanying remarks applicant noted:

"new claims 24-29 have been presented directed to the method of the present invention and which are readable on the species identified as I and the species identified as B, as previously elected, with traverse, in the Response filed March 29, 1996. Accordingly, applicants submit that claims 24-29 should be considered together with the other claims indicated as readable on the elected species."

Inspection of the ensuing Office action of July 5, 1996 (at 3) reveals the examiner's treatment of those claims:

"Newly submitted claims 24-29 are directed to an invention that is independent and distinct from the invention originally presented and, originally elected in the March 29, 1996 response...Accordingly, the apparatus invention of original claims 1-23 has been constructively elected by original presentation of claims as well as by applicants

(sic, applicants') **specific election in the 3/29/96 response of species I,B of said apparatus claims** on the merits
[underlining in original, emphasis added]."

Inspection of the above-emphasized portion of that Office action, however, contradicts petitioner's contentions that "there is no statement in the Office action of July 5, 1996 that the claims 24-29 are not readable on the elected species (emphasis in original)." Rather, it is clear that the examiner, while making an assertion of constructive non-election, nevertheless, also asserted that method claims 24-29 "were independent and distinct" from the invention originally elected in March 29, 1996; more particularly that a "specific election" of species I,B of said apparatus claims precluded a finding that method claims 24-29 could be considered to read on the elected apparatus species.

However, applicants responded in the petition of July 30, 1996 that (1) claims 24-29 were presented prior to an action on the merits, and, as such, could not be properly held to have been constructively non-elected, and (2) "noted that claims 24-29, although directed to a method rather than an apparatus, are considered to be readable on the elected species." The petition requested that a complete Office action be issued, i.e., one that included a treatment on the merits of claims 24-29.

The decision of December 31, 1996 denied the aforementioned petition and noted, *inter alia*, that "newly presented claims 24-29 were properly considered and not found to be readable on the elected species." At this point, the decision, clearly acknowledges the existence on the record of a disagreement between applicant and examiner, as to whether claims 24-29 are directed to the elected subject matter.

Petitioner filed a request for reconsideration of the above-noted decision, and therein again sought issuance of a complete Office action on January 7, 1997, which request was denied in the decision of February 6, 1997. The decision noted in essence, that a complete Office action had been given in that while claims 24-29 had not been treated on the merits, claims 24-29 were not readable on the elected species. Again, the disagreement between applicant and the examiner as to whether claims 24-29 are directed to the elected subject matter was noted.

It is manifest from consideration of the above that petitioners have, since the initial presentation of claims 24-29 on June 14, 1996, maintained that these claims are readable on the invention elected March 29, 1996. It is equally clear that the examiner has maintained during this interval that these same claims do not read on the elected invention. Thus, the issue fairly presented

since the supplemental amendment of June 14, 1996 has been whether claims 24-29 are readable on the elected invention. The examiner's action of July 5, 1996 held that claims 24-29 did not read on the elected invention, in the face of applicant's prior assertion to the contrary. Applicant clearly traversed the examiner's holding in the petition of July 30, 1996. At that point, the question--as to whether claims 24-29 "read on" the elected invention--under current PTO policy was no longer a petitionable matter. Rather, that issue was now appealable, notwithstanding the decision on petition of December 31, 1996.

As set forth in MPEP § 821:

"All claims that the examiner holds as not being directed to the elected subject matter should be withdrawn from further consideration by the examiner as set forth in MPEP § (c) and § 821.01 through § 821.03. As to one or more of such claims the applicant may traverse the examiner's holding that they are not directed to the elected subject matter. The propriety of this holding, if traversed, is appealable. Thus, if the examiner adheres to his or her position after such traverse, he or she should reject the claims to which the traverse applies on the ground that they are not directed to the elected subject matter. Because applicant believes the claims are readable on the elected invention and the examiner disagrees, the metes and bounds of the claim(s) cannot be readily ascertained, rendering the claim(s) vague and indefinite within the meaning of 35 U.S.C. 112, second paragraph." (emphasis added)

Under the Office policy set forth in the quoted section of the Manual, where, as here, an applicant believes that claims are readable on an elected species and the examiner disagrees, the proper course for the examiner to take is to reject the claims as being vague and indefinite within the meaning of 35 USC § 112, second paragraph. However, the examiner's course of action on this case was to withhold the aforementioned claims from further consideration, which under the facts noted above, was not in accord with Office policy.

Since the examiner disagreed with petitioner's identification of the claims which were readable on the elected specie(s), claims 24-29 should have been made the subject of a rejection under 35 USC 112 ¶ 2, and should not have been withheld from further consideration. In this regard, it is the long-established policy of the Patent and Trademark Office to maintain the line of demarcation between matters which are appealable, and those which are petitionable. MPEP 1201. It is well settled that the Commissioner will not, on petition, usurp the functions or

impinge upon the jurisdiction of the Board of Patent Appeals and Interferences. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971). As such, the treatment of claims 24-29 to date, which is not consistent with established policy, cannot be permitted to continue. To the extent that the previous decisions did not point out that any Office action mailed on or after July 30, 1996, to be complete, had to include the above-mentioned rejection of claims 24-29, those decisions are in error.

Since the final Office action of May 12, 1997 did not include a rejection under 35 USC 112, second paragraph, of claims 24-29, the finality of that action was not in accordance with current Office practice. That is, 37 CFR 1.113(b) requires "[i]n making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor," which was clearly not done in this case.

Accordingly, the finality of the Office action of May 12, 1997 is vacated. This application is being forwarded to the examiner for issuance of a supplemental Office action which includes a treatment of claims 24-29 not inconsistent with this decision.

CONCLUSION


Petitioner's request that the Commissioner invoke his supervisory authority under 37 CFR 1.181(a)(3) for review of the decisions on petition mailed May 31, 1996 and February 6, 1997 is granted. These decisions have been reconsidered, and under the circumstances of this case, it is appropriate to vacate the finality of the outstanding Office action. Since the examiner will, in due course, issue a supplemental Office action that treats claims 24-29 in the manner indicated above, to that extent petitioner's request for a "complete" Office action is granted.

Petitioner additionally requests a refund of the three month extension of time fee which was necessitated by a delay in the Group Director not rendering a decision on the petition filed July 30, 1996 until December 31, 1996. 35 USC 42(d) permits refund of "any fee paid by mistake or any amount paid in excess of that required." The amount was owed at the time it was paid, and it was paid by a duly authorized representative of the applicant. This is not a "mistake" as contemplated by the statute. See 37 CFR 1.26. As correctly pointed out in the decision of February 6, 1997, 37 CFR 1.181(f) specifically states:

The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

Accordingly, the request for a refund is denied.

This application is being returned to the examiner for issuance of a supplemental Office action consistent with this decision.

for 
Robert E. Garrett
Director, Group 3600